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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,642	12/31/2001	Thomas Edward Mungavan	C27-002-01-US	5809
22854	7590	09/08/2006	EXAMINER	
MOORE, HANSEN & SUMNER, PLLP 225 SOUTH SIXTH ST MINNEAPOLIS, MN 55402			STRANGE, AARON N	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,642

Applicant(s)

MUNGA VAN ET AL.

Examiner

Aaron Strange

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The declaration filed on 6/7/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the 6,741,980 reference.
2. It appears that Applicant intends to show invention of the claimed subject matter prior to the Jan 21, 2000 filing date of US Patent 6,741,980, to Langseth et al. by showing conception of the invention prior to Jan 21, 2000 coupled with due diligence from prior to Jan 21, 2000 to the filing date of the present application, December 31, 2001.
3. It should be noted that US Patent 6,741,980, to Langseth et al. claims priority to US Provisional Patent Application 60/126,055, which has a filing date of Mar 23, 1999. Accordingly, the effective filing date of Langseth et al. is Mar 23, 1999.

### **I. Formalities**

4. The declaration filed 6/7/2006 is signed only by Mr. Mungavan. Since the reference Applicant is attempting to overcome applies to all pending claims in whole or in part, Applicant should provide a declaration from each of the inventors, or provide a showing of facts which shows unavailability of the non-signing inventors.

### **II. Conception**

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5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Langseth reference (3/23/1999). While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

6. The affidavit or declaration and exhibits submitted by Applicant must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts to essentially a mere pleading, unsupported by proof or a showing of the facts", and, thus, does not satisfy the requirements of 37 CFR 1.131(b). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by Applicant. (See MPEP 715.07, 1).

7. Applicant asserts that "On or about February 7, 1999, I conceived of the above captioned invention and attempted to partner with a potential funding source". However, no evidence showing conception has been presented. The only exhibits provided have been asserted by applicant to have been generated after the effective filing date of Langseth.

Only Exhibits B-E appear to show anything related to the invention, but no explanation of how they show conception of any of the claim elements has been provided. Applicant should explain the specific parts of exhibits that are intended to show evidence of conception of claimed subject matter.

## II. Diligence

8. In determining the sufficiency of a 37 CFR 1.131 declaration/affidavit, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. (See MPEP 715.07(a)). However, in the interest of compact prosecution, the Examiner notes the following deficiencies. It should be noted that these remarks are designed to assist Applicant and should not necessarily be considered comprehensive.

9. The currently presented evidence of diligence is inadequate. Applicant attempts to account for a time period of nearly 3 years and discloses only 7 events. Particularly concerning is the time period between Jan 24, 2000, when Applicant asserts that the invention, as conceived, was "effectively reduced to practice", and December 31, 2001, when the present application was filed. A mere assertion of "further development" during this time period is not sufficient to show diligence.

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA

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1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field).

The time periods between events asserted by Applicant are generally large and inconsistent with reasonable diligence. Applicant must account for the time period between Mar 23, 1999 and Dec 31, 2001 with far more specificity that has been currently provided.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-27 are rejected under 35 U.S.C. 102(b) for being in public use more than one year prior to the filing date of the present application.

12. Applicant has asserted "On or about Dec 26, 2000, the system was functioning and delivering subscriptions to customers." (Declaration filed on 6/7/2006). Since the

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above events occurred more than one year prior to the filing to the present application, this is clear evidence that the invention was in public use.

To overcome the present rejection, Applicant must provide factual evidence that the broadest pending claim contains limitations directed to subject matter which was not present in "the system" as present prior to Dec 31, 2000 or that the only public use occurred outside of the United States.

13. Claims 1-6,8-10,12-17, and 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Langseth et al. (US 6,741,980).

14. With regard to claims 1 and 13, Langseth discloses a distribution system for delivering dynamically assembled media, the distribution system comprising:

a plurality of custom content media programs arranged into discrete, subscriber selectable products (services provide various content from the database) (Col 7, Lines 16-21);

an assembler for bundling a predetermined number of subscriber selected products to create individualized subscriber specific packages (subscribers can subscribe to any number of services) (Col 7, Lines 33-40); and,

a processor for transmitting the subscriber specific packages in a predetermined order to a subscriber (service delivery may be scheduled) (Col 7, Line 55 to Col 8, Line 13).

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15. With regard to claim 2, Langseth further discloses a builder for designing the custom content media programs (services are created) (Col 7, Lines 16-17).

16. With regard to claims 3 and 14, Langseth further discloses that a portion of the custom content media programs comprise dynamic content (live sports scores, stock tickers, specifically created audio content, etc)(Col 8, Line 54 to Col 11, Line 20).

17. With regard to claims 4 and 15, Langseth further discloses that a portion of the custom content media programs is generated dynamically, just prior to transmission (live score alerts and stock tickers are dynamically generated just prior to being transmitted) (Col 8, Line 63 and Col 10, Line 45).

18. With regard to claims 5 and 16, Langseth further discloses that the custom content media programs are encoded and compressed prior to transmission (Real Audio transmissions) (Col 11, Lines 7-12).

19. With regard to claim 6, Langseth further discloses that the system is able to collect and distribute a predetermined number of subscriber specific package transmissions across multiple networked hardware devices (transmissions may be distributed to a plurality of data distribution servers) (Col 15, Lines 35-54).



20. With regard to claims 8 and 17, Langseth further discloses that a portion of the custom content media programs is interactive (links to related content) (Col 22, Lines 36-39).

21. With regard to claim 9, Langseth further discloses that a portion of the custom content media programs is based upon predetermined demographic criteria (preferred music type) (Col 11, Lines 7-12).

22. With regard to claim 10, Langseth further discloses the custom content media programs may be modified based upon feedback from a subscriber (users may modify their profile which would change the provided services) (Col 12, Lines 61-67).

23. With regard to claim 12, Langseth further discloses that a portion of the custom content media programs comprises third party information (subscription interface), and wherein the third party information is used to modify the program to meet a subscriber's changing needs (interface allows information about subscriber to be collected in order to customize the program content)(Col 12, Lines 61-67).

24. With regard to claim 19, Langseth further discloses that the step of creating custom content media programs comprises the step of selecting content that is specific to a subscriber (content may be personalized for subscribers) (Col 7, Lines 37-40).

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25. With regard to claim 20, Langseth discloses a method of customizing delivery of dynamically assembled, personalized media to a subscriber, the method comprising the steps of:

a. creating a plurality of custom content media programs arranged into discrete subscriber selectable products (services provide various content from the database)

(Col 7, Lines 16-21);

b. assembling subscriber selected discrete products to create a personalized subscriber specific package (subscribers can subscribe to any number of services) (Col 7, Lines 33-40);

c. transmitting the package to a subscriber (Col 7, Line 55 to Col 8, Line 13); and

d. modifying subsequent transmittals (each transmittal will change when real time information such as stock prices and sports scores (Col 8, Line 63 and Col 10, Line 45) is provided or when subscriber modifies their profile) (Col 12, Lines 61-67).

26. With regard to claim 21, Langseth further discloses that the step of modifying subsequent transmittals is based upon subscriber related responses generated by the subscriber (subscribers may modify their profile which would change the provided services) (Col 12, Lines 61-67).

27. With regard to claim 22, Langseth further discloses that the step of modifying subsequent transmittals is based upon subscriber related responses generated by a third party (newly received data will be reflected in subsequent transmittals)(Col 13, Lines 51-65).

28. With regard to claim 23, Langseth further discloses that the step of modifying subsequent transmittals is generated at predetermined intervals (updates may be received after a predetermined interval) (Col 7, Lines 64-66).

29. With regard to claim 24, Langseth further discloses that the step of modifying subsequent transmittals is based upon archived, personal data (updates in user profiles will be reflected in subsequent transmissions) (Col 12, Line 61 to Col 13, Line 16).

30. With regard to claim 25, Langseth further discloses that the step of assembling the products into a subscriber specific package includes the generation of customized content just prior to the step of transmission (live score alerts and stock tickers are dynamically generated just prior to being transmitted) (Col 8, Line 63 and Col 10, Line 45).

31. With regard to claim 26, Langseth further discloses that the multiple networked hardware devices are from a group comprising: a computer (Col 15, Lines 35-54); a portable mp3 player, a mobile telephone, and a personal digital assistant (PDA).

32. With regard to claim 27, Langseth discloses a distribution system for delivering dynamically assembled media, the distribution system comprising: a plurality of custom

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content media programs, with each program arranged into a plurality of discrete subscriber selectable products (services provide various content from the database and are customized for each user) (Col 7, Lines 16-21); an assembler for bundling a predetermined number of subscriber selected discrete products to create subscriber specific packages (subscribers can subscribe to any number of services) (Col 7, Lines 33-40); and, a processor for transmitting the subscriber specific packages in a predetermined order to a subscriber (service delivery may be scheduled) (Col 7, Line 55 to Col 8, Line 13).

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,741,980) in view of Official Notice.

35. With regard to claim 7, while the system disclosed by Langseth shows substantial features of the claimed invention (discussed above), it fails to specifically recite that the system has the ability to analyze feedback and retransmit subscriber specific packages that fail to be transmitted successfully.

The Examiner takes Official Notice that retransmitting data that fails to be transmitted successfully is old and well known in the art. It is well known that computer networks are not 100% reliable, and failed transmissions may occur for a large number of reasons. Monitoring for feedback such as an acknowledgement packet and retransmitting content which fails to be transmitted successfully would be advantageous since it would have ensured delivery of the content to the subscriber. Langseth further discloses that FTP may be used to transmit the custom content to subscribers (Col 14, Lines 16-34). FTP uses TCP/IP as a transport protocol, and it is well known that TCP/IP provides retransmission of failed transmissions, as shown by RFC 2988 (At least Page 1, Section 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to monitor feedback and retransmit subscriber specific packages that fail to be transmitted successfully. This would have ensured delivery of the content to the subscriber.

36. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langseth et al. (US 6,741,980) in view of Levy (US 2002/0052885).

37. With regard to claims 11 and 18, while the system disclosed by Langseth shows substantial features of the claimed invention (discussed above), it fails to disclose that a portion of the custom content media programs includes embedded information designed to deter file sharing.

Levy teaches a method of deterring sharing of audio files that are distributed via the Internet. Levy discloses embedding information in the audio files that prevents indicates whether or not the file is allowed to be shared (Par 41). This would have been an advantageous addition to the system disclosed by Langseth, since Langseth discloses the delivering personalized radio content (Langseth, Col 11, Lines 4-21). This would have prevented users of the system from sharing the received audio files with users who had not paid for them.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include embedded information in the audio files distributed by Langseth to deter file sharing. This would have prevented users of the system from sharing the received audio files with users who had not paid for them.

### ***Conclusion***

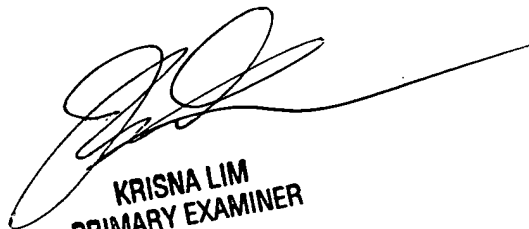
38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS  
8/22/2006



KRISNA LIM  
PRIMARY EXAMINER